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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,559	12/19/2000	Bridget D. Kimball	18926-003500US	4506
20350	7590	07/07/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/740,559

Applicant(s)

KIMBALL ET AL.

Examiner

Zachary A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. An amendment was received on 21 April 2005. Claims 1, 9, and 14 have been amended. New Claims 21-26 have been added. No claims have been canceled. Claims 1-26 are currently pending in the present application.

Response to Arguments

2. Applicant's arguments filed 21 April 2005 have been fully considered but they are not persuasive.

In reference to the rejection of Claims 1-4, 6-11, 13-17, 19, and 20 under 35 U.S.C. 102(b) as anticipated by Wasilewski et al, US Patent 5420866, Applicant argues that Wasilewski does not teach transport of messages that are authorized for receipt by a conditional access receiver, and instead only discloses authorization of video streams. The Examiner respectfully disagrees. Although the Examiner does agree that Wasilewski does teach transport of video streams that are authorized, the Examiner believes that Wasilewski also discloses transport of messages that are authorized (see, for example, column 14, lines 62-68, where the Entitlement Management Messages are sent to authorized receivers). Further, the Examiner notes that the elementary streams, which make up the programs disclosed by Wasilewski, can include not only video streams, but also audio streams *and other data*, which reads on the claimed messages (see column 1, lines 27-35).

In reference to the rejection of Claims 5, 12, and 18 under 35 U.S.C. 103(a) as unpatentable over Wasilewski in view of McClellan, US Patent 5619250, Applicant argues that a combination of McClellan and Wasilewski would authorize a video stream but not a software message. This argument appears to be based on the assumption that Wasilewski does not teach authorization of messages, which has been addressed above regarding the rejections under 35 U.S.C. 102(b).

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

It is noted that Applicant's arguments persist in being not fully responsive under 37 CFR 1.111(b). The amendment must present arguments that point out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The Examiner notes the absence of arguments regarding new Claims 21-26.

Claim Objections

3. The objections to Claims 6 and 19 under 37 CFR 1.75(c) for failing to further limit the subject matter of a previous claim are withdrawn in light of Applicant's arguments.

Claim Rejections - 35 USC § 112

4. The rejections of Claims 1-20 under 35 U.S.C. 112, first and second paragraphs, are withdrawn. The Examiner thanks Applicant for clarification of the issue at hand.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6-11, 13-17, 19-21, 24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasilewski, US Patent 5420866.

In reference to Claim 1, Wasilewski discloses a method for distributing a message and a video stream in a conditional access system including receiving a video stream (column 13, line 60-column 14, line 4, for example), authorizing use of the video stream by the receiver (column 14, line 68-column 15, line 6), receiving authorization information (column 14, lines 33-37), storing authorization information (column 11, lines 26-29), determining an identifier with the authorization information (column 13, lines 53-60), determining if the receiver is authorized to receive the message (column 14, lines 62-65), and blocking receipt of the message if the receiver is not authorized (column 14, line 68-column 15, line 6, where if a receiver is authorized, the program is output, noting

column 1, lines 17-25, where the program can include video, audio, and other data streams).

In reference to Claim 2, Wasilewski further discloses recognizing that the message corresponds to the identifier (column 13, lines 56-63) and ignoring a portion of a datastream associated with the message (column 13, lines 60-63, where only some of the packets are extracted).

In reference to Claim 3, Wasilewski further discloses that determining the identifier includes retrieving a subtype identifier from a header (column 8, line 68-column 9, line 6, where the header includes packet IDs).

In reference to Claim 4, Wasilewski further discloses that determining if the receiver is authorized includes determining entitlement for the message (column 14, lines 62-65, where the EMM is an Entitlement Management Message).

In reference to Claim 6, Wasilewski further discloses that the method includes receiving an authorization message (column 14, lines 33-37).

In reference to Claim 7, Wasilewski further discloses that the authorization information is stored in solid state memory (column 13, lines 44-45).

In reference to Claim 8, Wasilewski further discloses checking authorization within the receiver (column 14, lines 62-65).

In reference to Claim 21, Wasilewski further discloses that the authorization information includes a programming tier (column 4, lines 55-59).

In reference to Claim 24, Wasilewski further discloses sending the authorization information and message through different channels at different times (see column 8,

line 68-column 9, line 6, and column 9, line 59-column 10, line 7, where the authorization information and elementary streams have different PIDs).

In reference to Claim 26, Wasilewski further discloses a domain identifier (see column 10, lines 65-68, where the EMMs can be sent to groups of receivers).

In reference to Claim 9, Wasilewski discloses a method for distributing a message and a video stream in a conditional access system including receiving the video stream at a first receiver (column 13, line 60-column 14, line 4, for example), authorizing use of the video stream by the first receiver (column 14, line 68-column 15, line 6), receiving authorization information at the first receiver (column 14, lines 33-37), determining if the first receiver is authorized to receive the message (column 14, lines 62-65), receiving authorization information at a second receiver (column 14, lines 33-37), determining if the second receiver is authorized to receive the message (column 14, lines 62-65), blocking receipt of the message in the first receiver if the first receiver is not authorized (column 14, line 68-column 15, line 6, where if a receiver is authorized, the program is output), and receiving the message in the second receiver if the second receiver is authorized (column 14, line 68-column 15, line 6).

In reference to Claim 10, Wasilewski further discloses ignoring a portion of a datastream associated with the message (column 13, lines 60-63, where only some of the packets are extracted).

In reference to Claim 11, Wasilewski further discloses that determining if the first receiver is authorized includes determining entitlement for the message (column 14, lines 62-65, where the EMM is an Entitlement Management Message).

In reference to Claim 13, Wasilewski further discloses checking authorization within the first receiver (column 14, lines 62-65).

Claims 14-17, 19, and 20 are directed to a software program product and correspond substantially to method claims 1-4, 6, and 7, respectively, and are rejected by a similar rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 12, 18, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski in view of McClellan et al, US Patent 5619250.

In reference to Claims 5 and 12, Wasilewski discloses everything as applied to Claims 1 and 9 above. Also in reference to Claims 22 and 23, Wasilewski discloses everything as applied to Claim 1 above. However, Wasilewski does not specifically disclose that the message includes a software program, a version identifier, or a

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firmware upgrade. In reference to Claims 5 and 12, McClellan discloses a system for television system set top boxes that includes receiving a software module sent from a central system in a set top box (column 7, lines 23-28). In reference to Claim 22, McClellan further discloses a version identifier sent from a central system to a set top box (see column 8, lines 51-63). In reference to Claim 23, McClellan discloses that the software module can be an upgrade (column 7, lines 23-28) for firmware (column 8, lines 19-23, where the upgrade is stored in FLASH memory). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the methods of Wasilewski to include sending software programs and upgrades in the conditional access system, in order to allow for software modules to be downloaded after the system has been initialized and to be functional upon receipt without the need for restarting the system (see McClellan, column 5, lines 10-14).

Claim 18 is a software program product claim that corresponds substantially to the method of Claim 5, and is rejected by a similar rationale.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski in view of Schneier, *Applied Cryptography*.

In reference to Claim 25, Wasilewski discloses everything as applied to Claim 1 above. However, Wasilewski does not explicitly disclose determining a signature over the message. Schneier discloses the use of digital signatures, using various cryptographic protocols to verify the integrity of messages (see pages 34-41, section

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2.6, "Digital Signatures", noting especially page 37, "Signing Documents with Public-Key Cryptography"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Wasilewski by including the use of digital signatures, in order to provide an authentic and unforgeable means of verification that cannot be repudiated (see page 35, items 1-5).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Matthew B. Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
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